

Fletcher, William

From: Meeks, Timothy
Sent: Monday, August 27, 2007 12:33 PM
To: Fletcher, William
Subject: RE: double patenting

The first application should be passed to issue if this is the only remaining rejection (provisional ODP).

The ODP rejection has to be resolved in the second application at this point because it is no longer provisional (first case passed to issue). There cannot be two patents for the same invention without a TD. Therefore, his only choices would be to amend or cancel the claims in the second application to overcome the ODP rejection. Alternatively, they could transfer ownership to one assignee and make the TD.

Not very attractive but all I know of to overcome this

-----Original Message-----

From: Fletcher, William
Sent: Monday, August 27, 2007 12:03 PM
To: Meeks, Timothy
Subject: double patenting

Hi Tim and welcome back! Here's a brain teaser for you on a Monday afternoon....

I have two cases, 10/440,022 and 10/671,381. I have rejected claims in '022 under ODP in view of '381 and I have rejected claims in '381 under ODP in view of '022.

According to the attorney, these cases are not commonly owned so he cannot file TDs. Referring to MPEP 804(I)(B)(1), the attorney feels that the '381 application represents the "base" invention and should be allowed to issue, but is unsure how to resolve the ODP rejections in the '022 case. He is willing to cancel the rejected claims, but would like to avoid it if possible.

Are there any other options open to him apart from cancelling the rejected claims in the '022 case?

Thanks!

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